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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,317	07/02/2001	Marc Seghatol	155036US02	1736

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EXAMINER

LEWIS, RALPH A

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 07/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/897,317

Applicant(s)
SEGHATOL

Examiner
Ralph Lewis

Art Unit
3732



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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Foreign Priority

Applicant's claim for foreign priority based on Canadian Application 2,246,663 is noted, however, no certified copy has been received. A certified copy of the Canadian application is not present in the parent application 09//399,580 file. The notice of allowability mailed 2/12/2001 in parent application 09//399,580 indicated that the certified copy had not yet been received and there is no indication that applicant filed the certified copy prior to issue of the parent.

Objection to the Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hand held tool having both a microwave antenna and a mechanism to deliver resin as set forth in claim 10 and the "means for providing cooling" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Objection to the Specification

The specification is objected to 37 CFR 1.71 as failing to include a description as to what constitutes the "means for cooling."

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Rejections based on 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-13 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 8 and 9, it is unclear what structural limitations applicant is attempting to impose upon the claimed system with limitations directed to how applicant intends for the claimed system to be used. Placing limitations on an element that is not a part of the claimed system is confusing.

In claim 11, it is unclear how the limitations directed to a method further limit the structure of the claimed system.

In claim 12, it is unclear from the description what constitutes the “means for providing cooling.”

In claims 13 and 16, it is unclear how the “antenna choke” is related to the previously claimed “antenna positioned at the distal end of the tool and configured to be selectively positioned within the mouth of a patient adjacent at least one exterior surface of a tooth.” The specification gives no guidance.

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Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper tames extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.d. 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,254,389 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have found it obvious to set forth the microwave dental system claimed in '389 in the broader terms of the present application.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1, 8, 9, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevens et al (5,421,727).

Stevens discloses a microwave dental system with a hand held tool 410, antenna 422, wave guide 24 (connected at 440) and source of microwave energy 50 having a control system (column 3, line 51- column 4, line 4). Stevens only appears to disclose the application of the tool to the interior of the tooth through the root canal whereas applicant's apparatus claims call for the device to be used on "at least one exterior surface." It is noted, however, that the Stevens et al device is capable of being positioned adjacent an exterior surface - the manner in which applicant intends for the device to be used fails to impose any objectively ascertainable structural distinctions from the device disclosed by Stevens et al. In regard to claims 8, 9, and 11, the manner in which applicant intends for the claimed device to be used fails to impose any objectively ascertainable structural distinctions from the device disclosed by Stevens et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 2-5, 7, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al (5,421,727).

Stevens makes it clear that the power levels and frequencies can be adjusted to a variety of different levels (see column 3, lines 38 column 4, line 4), merely adjusting the adjustable control system as suggested by Stevens et al would have been obvious to one of ordinary skill in the art.


Prior Art

Applicant's information disclosure statement of February 01, 2002 has been considered and an initialed copy enclosed herewith.

Ito et al (5,026,959), Fakhri (5,207,231), Hurter et al (5,358,515), Kowalyk et al (5,456,603), Edwards et al (6,033,401), Cohen (6,036,494) and Chou (6,083,218) are made of record.

Any inquiry concerning this communication should be directed to Ralph Lewis at telephone number (703) 308-0770. Fax (703) 872-9302. The examiner works a compressed work schedule and is unavailable every other Friday.

R.Lewis
June 17, 2002



Ralph A. Lewis
Primary Examiner
Aw3732